

REMARKS

By this paper, the Applicant has amended Claims 1 and 19. Thus, Claims 1-23 remain pending and are presented for further examination.

I. Discussion of Claim Rejections Under 35 U.S.C. § 102(b)

In paragraph 3 of the Office action, the Examiner rejected Claims 1, 2, 5-7, 11, 12, 16-19, 22, and 23 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,375,159 to Williams. In rejecting independent Claims 1 and 19, the Examiner indicated that Williams discloses all of the limitations of Claims 1 and 19.

A. The Law of Anticipation

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). More particularly, a finding of anticipation requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The Applicant submits that, in light of the amendments to the claims, Williams fails to teach or suggest all of the limitations of Claims 1-9 and 19-23, as discussed below.

B. Brief Description of U.S. Patent No. 5,375,159 to Williams

Williams teaches a system comprising "a dual port protocol analyzer [] situated at the site of each of two paired [signal transfer points] STPs for operation in a master and slave analyzer module capacity." *Williams at col. 3, ll. 36-40*. A simultaneous test of paired SS7 links or lines is then performed from the control or master analyzer module at STP A by commanding the system to select the port or SS7 interface at STP A which is linked to the central office under test. *Id. at col. 3, ll. 45-49; see Fig. 2*. Each analyzer comprises a control module 42, 44 having associated monitors and keyboards 46, 48 and port selectors 50, 52. *Id. at col. 5, ll. 12-14; see Fig. 3*. In one example, the operator or technician at STP A commands the dual port analyzer in

STP A, including control module 42 and port selector 50, to select interface or port Number 1 as the central office selected for test. *Id. at col. 6, ll. 41-46.* A loop connection is created by a bridging connection between the A-link 32 connected to port Number 1 in STP B and an available data communication link between the two port selectors 50 and 52, such as two DS0 channels from a T1 link 78. *Id. at col. 6, ll. 59-68; see Fig. 6.*

C. Williamson Fails to Teach or Suggest all of the Limitations of Claims 1-9 and 19-23

As noted above, Williams describes that each analyzer comprises a control module 42, 44 having associated monitors and keyboards 46, 48 and port selectors 50, 52. *Id. at col. 5, ll. 12-14; see Fig. 3.* The control module (e.g., 42) and associated monitor/keyboard 46 (e.g., 46) are co-located with the analyzer of the Williams system. Thus, one disadvantage of the Williams system lies in the inability of an operator or technician to *remotely* command a plurality of analyzers that are in data communication with the network.

On the other hand, the Applicant has amended Claim 1 to clarify that the computer is located at a location that is different from the location of the first and second analyzer units. Similarly, the Applicant has amended Claim 19 to clarify that the controlling means is located at a location that is different from the location of the first and second analyzing means. Thus, one of the advantages of the invention recited in Claim 1 allows, e.g., a technician to *remotely* command the first and second network analyzers from a distance, e.g., via another network or data link. For example as the specification provides, "[i]n one embodiment, a central station, such as the NOC 130, remotely controls the analyzer units 110, 120, and 140, via the network 100, which may include an ATM, Frame Relay, ISDN, SONET, and Internet, or a dedicated link such as a direct dial-up." *Spec. at page 7, ll. 1-3; see also Fig. 1.* Clearly, Williams fails to teach or suggest a system comprising a computer that is at a location that is different from the location of the first and second analyzer units, as recited in Claim 1. Since Claim 19 includes at least this patentable feature of the invention recited in Claim 1, Williams also fails to teach or suggest all of the limitations of Claim 19. Also, it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Williams and recognize the invention recited in Claims 1 and 19. Thus, the Applicant submits that Claims 1 and 19 are allowable. ①

Since Claims 2-8 and 20-23 depend either directly or indirectly on one of Claims 1 and 19, the Applicant submits that those claims are also allowable.

II. Discussion of Rejection of Claims 8-18 Under 35 U.S.C. § 102(b) and § 103(a)

In paragraph 6 of the Office action, the Examiner rejected Claims 10, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Williams in view of U.S. Patent No. 5,796,723 to Bencheck et al. ("Bencheck"). In rejecting Claim 10, the Examiner noted that Williams "failed to disclose the parameter deviation, based on a predetermined base line and issue an alert." *O.A. at page 4*. The Examiner noted, however, that "Bencheck discloses an alert indicating that a performance monitoring parameter has exceeded a predefined threshold (col. 16, lines 20-23)." *Id.* The Examiner argued that "it would have been obvious to a person of ordinary skill in the art to use the base line as a benchmark to set limits and alarm the network when exceeding ... [and to be] motivated to use a predetermined base line and issue alert because it is part of the trouble isolation process and detect failure before experiencing network degradation." *Id.* For at least the reasons set forth below, the Applicant respectfully disagrees with the Examiner's determination that the invention recited in Claim 10 would have been obvious over Williams in view Bencheck.

No motivation

A. The Law of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the references when combined must teach or suggest all of the claim limitations. See *M.P.E.P.* § 2143. It is well settled that "a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obviousness holding'." See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000). The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fitch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). "Determination of obviousness cannot

be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998). For at least the reasons set forth below, the Applicant respectfully submits that there is no suggestion or motivation to combine the reference teachings, as argued by the Examiner.

B. Brief Description of U.S. Patent No. 5,796,723 to Bencheck

Bencheck describes a system and method for identifying monitoring points within a network pursuant to a customer request. *Bencheck at col. 3, ll. 18-20*. Bencheck further describes a system and method for setting monitoring thresholds for services provisioned by the service provider. *Id. at col. 3, ll. 37-39*. Criteria such as the circuit path length and the type of service are used to establish thresholds for a particular service. *Id. at col. 3, ll. 39-41*. These customized thresholds are used by monitoring points to determine when a provisioned service experiences unacceptable levels of degradation. *Id. at col. 3, ll. 45-48*. A typical reported error event reported to a service management layer (SML) 630 is a threshold crossing alert (TCA), an alert indicating that a performance monitoring parameter has exceeded a predefined threshold. *Id. at col. 16, ll. 20-23; see Figs. 6 and 12*. In yet another aspect, Bencheck describes a system and method for activating previously identified monitoring points in the event that a degradation or failure is detected at the path endpoints. *Id. at col. 3, ll. 49-52*.

C. There Would Not Have Been a Motivation to Combine the Teachings of Williams and Bencheck *yes, Bencheck teaches performance monitoring*

As indicated above, Bencheck is directed to identifying monitoring points within a network pursuant to a customer request. *Bencheck at col. 3, ll. 18-20*. Bencheck does not teach or suggest establishing any link or measuring any parameters of a link between first and second analyzers, as recited in Claim 10. More importantly, there is no motivation to one of ordinary skill in the art in either Williams or Bencheck, and the Examiner did not point out where and why there would have been a suggestion, to selectively use the threshold crossing of Bencheck to incorporate into the Williams system. For example, there is no indication that any of the threshold setting or crossing suggested in Bencheck’s service provider circuits would work or be operable with protocol analysis of the Williams system. The mere fact that Bencheck discloses

threshold crossing cannot support a basis to create a motivation to one of ordinary skill in the art to modify the Williams system, as required by law. The Examiner is required to show "some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fitch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The Applicant submits that the Examiner's reliance on the assertion that use of a predetermined baseline "is part of the trouble isolation process" is insufficient. This amounts to determining obviousness based on the hindsight combination of components selectively culled from the Bencheck and Williams to fit the parameters of Claim 10. See *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

Therefore, the Applicant submits that Claim 10 is allowable. Since Claims 11-18 depend either directly or indirectly on Claim 10, the Applicant submits that those claims are also allowable.

Since Bencheck does not cure the deficiency of Williams in connection with its failure to anticipate Claim 1, the Applicant submits that Claims 8 and 9 are allowable in view of their respective dependency on Claim 1.

D. Examiner Failed to Establish a Prima Facie Case of Anticipation for Claims 11, 12, and 16-18 *wrong grouping*

In paragraph 3 of the Office action, the Examiner rejected Claims 11, 12, and 16-18 for being anticipated by Williams. However, in paragraph 6 of the Office action, the Examiner stated that Williams failed to disclose the parameter deviation, based on a predetermined based line and issue an alert, while referring to Claim 10. The Applicant notes that Claims 11, 12, 16-18 depend directly or indirectly on Claim 10. As noted above, "to anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001). Since Williams fails disclose some limitations of Claim 10, the rejection of its dependent Claims 11, 12 and 16-18 under § 102(b) is improper. The Applicant respectfully requests that the rejection of those claims be withdrawn.

III. Discussion of Rejection of Claims 3 and 20 under 35 U.S.C. § 103(a)

In paragraph 4 of the Office Action, the Examiner rejected Claims 3 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Williams in view of U.S. Patent No. 5,600,632 to Schulman. The Applicant submits that Claims 3 and 20 depend on Claims 1 and 19, respectively. Since Schulman does not cure the deficiency of Williams in connection with its failure to anticipate Claims 1 and 19, the Applicant submits that Claims 3 and 20 are allowable in view of their respective dependency on Claims 1 and 19.

IV. CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns as expressed in the Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the clarity of the claims to particularly and distinctly point out the invention to those of skill in the art. Finally, Applicant submits that the claim limitations above represent only illustrative distinctions. Hence, there may be other patentable features that distinguish the claimed invention from the prior art.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and, particularly, that all claims be allowed. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully invited to call the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,
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Dated: September 2, 2003

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